

REMARKS

I. Introduction

Claims 14 to 29 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable. Reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgement of the claim for foreign priority and the indication that all copies of the certified copies of the priority documents have been received from the International Bureau.

II. Double Patenting Rejection

Regarding the double patenting rejection, while this rejection is not agreed with, to facilitate matters, Applicants are prepared to file a Terminal Disclaimer upon withdrawal of all other rejections and an indication that the present application is otherwise in condition for immediate allowance.

III. Rejection of Claims 14 to 16, 18 to 21, 28 and 29 Under 35 U.S.C. § 102(b)

Claims 14 to 16, 18 to 21, 28 and 29 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,342,592 (“Peter-Hoblyn et al.”).¹ For at least the following reasons, Applicants respectfully submit that Peter-Hoblyn et al. does not anticipate the presently pending claims.

Claim 14, as presented, relates to an atomizer nozzle for a fuel, including a nozzle body having an upper end and a lower end including spray-discharge orifices for discharging into a metering space and including at least one metering aperture situated at the upper end of the nozzle body, wherein the spray-discharge orifices are situated, with a radial directional component with respect to a center axis of the nozzle body, at elevation steps, and each elevation step includes at least one of the spray-discharge orifices, and at least one nozzle body insert including at least one flow-through opening and being situated in the nozzle body downstream of the at least one metering aperture, at least one of in front of a first of the elevation steps in a direction of fuel flow and between the elevation steps. Support for this amendment may be found, for example, at page 8, lines 8 to 10 of the Specification.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be

¹ It is assumed that “Peter-Hoblyn et al.” as referred to in the Office Action corresponds to U.S. Patent No. 5,342,592. Clarification is nevertheless respectfully requested so that the record is clear.

shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

The Final Office Action, at paragraph 5, refers to channel 54 of Peter-Hoblyn et al. as disclosing a metering aperture, shaft 40 as disclosing a nozzle body, and inner tube 41 as disclosing a nozzle body insert. As clearly shown in Figure 5 of Peter-Hoblyn et al., channel 54 is not situated at the upper end of shaft 40, and even if it is assumed, *arguendo*, that channel 54 is situated at the upper end of shaft 40, then inner tube 41 is not situated downstream of channel 54.

In contrast, claim 14 features a metering aperture situated at the upper end of the nozzle body, and a nozzle body insert situated downstream of the metering aperture. As described, for example, at page 6, lines 10 to 22 of the present application, this arrangement ensures that the fuel is metered via the metering aperture into the nozzle body and then flows downstream in the direction of the nozzle body insert.

Peter-Hoblyn et al. does not disclose, or even suggest, each and every feature of independent claim 14, or dependent claims 15, 16, 18 to 21, 28 and 29, which depend from claim 14 and therefore incorporate all of the features of claim 14. As such, Peter-Hoblyn does not anticipate the presently pending claims.

Withdrawal of this rejection is therefore respectfully requested.

IV. Rejection of Claims 22 and 25 to 27 Under 35 U.S.C. § 103(a)

Claims 22 and 25 to 27 are rejected under 35 U.S.C. § 103(a) as unpatentable over Peter-Hoblyn et al. For at least the following reasons, Applicants respectfully submit that Peter-Hoblyn et al. does not render unpatentable the present claims.

Claims 22 and 25 to 27 depend from claim 14 and therefore incorporate all of the features of claim 14. For at least the reasons more fully set forth above with respect to claim 14, Peter-Hoblyn et al. does not disclose or suggest all of the features of claim 14. As such, Peter-Hoblyn et al. does not disclose or suggest all of the features of claims 22 and 25 to 27, and therefore does not render unpatentable the present claims.

Withdrawal of this rejection is therefore respectfully requested.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Dated: March 11, 2009

By: /Clifford A. Ulrich/
Clifford A. Ulrich, Reg. No. 42,194 for
Gerard A. Messina (Reg. No. 35,952)

KENYON & KENYON LLP
One Broadway
New York, NY 10004
(212) 425-7200
CUSTOMER NO. 26646